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10/081,659	02/21/2002	Suresh K. Marisetty	42390P2319RC	4488

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EXAMINER

AUVE, GLENN ALLEN

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 01/29/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/081,659

Applicant(s)

MARISSETTY, SURESH K.

Examiner

Glenn A. Auve

Art Unit

2111

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 36-90 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-90 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Reissue Applications*

1. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

First of all, the new reissue declaration filed December 29, 2003, appears to incorrectly state the limitations present in the patented claims. The new declaration indicates that "claims of the original patent are limited to a 'device manager.'" However the patented claims are actually limited much more than that to a virtual device driver, not merely to a "device manager." The original claims in the parent also included the limitations directed to a "device driver" which is itself a narrower limitation than "device manager." Since this limitation has been incorrectly stated in the declaration it is not clear that it can form the basis of the alleged error.

Secondly, the alleged error appears to go to the question of impermissible recapture which forms the basis of the rejection of the claims. On this point, should it be determined that impermissible recapture does not exist in this case, then the rejections based on a defective reissue declaration would be overcome. However, the first error noted above would still need to be corrected.

Furthermore, the reissue declaration should refer not only to the application as filed, but also to the various amendments which have been made in the application.

2. Claims 36-90 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

3. Claims 36-90 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

As was noted in the previous action and in the parent case, the claims in this reissue application are broadened in a way that has resulted in an impermissible recapture of subject matter surrendered in the parent patent.

When determining whether recapture exists various test have been devised by the courts. The facts in Pannu and Clement appear to be most relevant to the facts in the present case. Those courts developed what are basically three part tests for determining whether or not recapture exists. First, did applicant broaden the claims; secondly, if so, is the broadening related to what was surrendered during prosecution of the patent; and third, have the claims also been materially narrowed. The Board in Ex parte Eggert basically reiterated this three part test, but went on to give some guidance regarding the third step of inquiry, namely that if the

reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection, then impermissible recapture does not exist as long as the replacement limitation provides a claim that is narrower than the subject matter "canceled" from the original application in order to overcome an art rejection.

The original or "surrendered" claim recites the use of a device driver for controlling power to various devices. The newly presented reissue claims do not include limitations drawn to the device driver or the virtual device driver limitation which was added in the amendment in order to make the patent claims allowable. Applicant freely added the "virtual" limitation to the claim and also argued it as the reason for allowability over the prior art. Even if only the original claim is what has been "surrendered", the claims in the reissue broaden even beyond that claim with respect to the fact that the reissue claims now only recite a power management module or program instructions for managing power consumption, and the device driver limitations are not present. Therefore, the claims are broader in that respect. So, with regard to the first part of the test, applicant's independent claims are broader than at least claim 11 of the patent.

Next, it is necessary to determine whether the broader aspect of the reissue claim is related to the surrendered subject matter. Applicant's original claim was rejected over the prior art to Smith and Stewart which showed a system with device drivers monitoring devices and controlling power to them. This rejection was overcome by adding the "virtual device driver limitation" to the claims. Therefore, the broadening removal of the device driver and virtual device driver limitations do broaden the claims in an aspect related to what was surrendered. The question then becomes whether or not the addition of power management module or instructions which control power to configurable devices is a material narrowing which avoids recapture.

It is submitted that the presence of the power management module or instruction limitations that measure the amount of time the processor has its clock stopped and reduce the voltage level applied to a processor as a result of the measuring in the reissue claims are not a material narrowing of the surrendered subject matter with respect to the prior art rejection. The rejection was related to the use of a device driver for controlling power to devices. The reissue claims are broader in that respect as noted above. The fact that other limitations have been added that are not related to either the use of a device driver or virtual driver, that is to say, the addition of the limitation that the processor has its voltage reduced in response to the amount of time it has its clock stopped, is not a material narrowing germane to the prior art rejection. Clement dealt with a similar issue in that the claims had been broadened with respect to the surrendered subject matter but had other narrowing limitations added. There the court found that recapture did exist because on balance the claims were broader than they were narrower in a manner directly related to the subject matter surrendered throughout prosecution. Clement at 1167. The same sort of situation exists in the present case.

Similarly, the facts in Pannu also seem to mirror those in the present case. In the present case the addition of the time determining and voltage reducing limitations are not necessarily related to the use of a device driver for controlling power. In Pannu the court found that, "The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather to the positioning and dimensions of the snag resistant means." That court decided that this fact meant that, "The reissued claims were not narrowed in any material respect compared with their broadening." Such a statement also applies to reissue claims in the present case in that any narrowing is with respect to the time determining and processor voltage reducing, not to the driver doing the controlling. Therefore, it is believed that impermissible recapture exists with respect to the claims.

Using the analysis of Eggert, the replacement limitations do not provide a claim that is narrower than the canceled claim subject matter. The replacement limitations are in fact broader than even the originally prosecuted claims because they eliminate the notion of a device driver altogether in addition to eliminating the virtual device driver limitation which was added to overcome the prior art rejection. Therefore, even in light of Eggert impermissible recapture exists in these claims.

### ***Response to Arguments***

4. Applicant's arguments filed December 29, 2003, have been fully considered but they are not persuasive.
5. With respect to the defective declaration, see above regarding the deficiencies of the newly submitted reissue declaration.

With respect to the issue of impermissible recapture, applicant has not really made any arguments related to the claim rejections or the examiner's analysis with respect to the legal precedents, but has merely set forth his analysis of case law and the statute. The examiner does not have any authority to overrule the decisions of the Federal Circuit or the Board.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

Art Unit: 2111

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (703) 305-9638. The examiner can normally be reached on M-Th 8:00 AM-5:30 PM, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Glenn A. Auve  
Primary Examiner  
Art Unit 2111

gaa  
January 26, 2004